

REMARKS

In response to the Office Action mailed May 26, 2009 ("the Office Action"), Applicants respectfully request reconsideration and reexamination of this application, removal of the rejections outlined below, and the timely allowance of the pending claims.

Status of the Claims

Claims 13-27 were pending in the application. Claims 1-12 were cancelled previously. By this amendment, Applicants amend claim 13. Claims 13-27 remain pending. Claims 21-27 have been withdrawn by the Examiner.

Rejection of Claims 13-15 and 17-18 Under 35 U.S.C. § 103(a)

Claims 13-15 and 17-18 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,375,823 to Navas ("Navas") in view of U.S. Patent No. 4,445,674 to Clayton ("Clayton"). Office Action at p. 3. The Examiner asserts that "Navas discloses the invention as claimed except for the first dampening element and the second dampening element each includ[ing] at least one inclined face." *Id.* at p. 4. The Examiner further alleges that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to manufacture the device of Navas wherein each of the dampening elements include[s] at least one inclined face in view of Clayton Jr. in order to help transfer heat from the device caused by friction." *Id.* Applicants respectfully traverse these section 103(a) rejections and request withdrawal of these rejections for at least the following reasons.

Claim 13 has been amended to recite, in part, that “the first dampening member and the second dampening member each include at least one inclined face contacting the enlarged end portion.” Neither Clayton nor Navas, alone or in combination, disclose, teach, or suggest such dampening members as claimed, and therefore, the Examiner has not established a *prima facie* case of obviousness.

Clayton does not teach a dampening member with an “inclined face contacting the enlarged end portion.” The Examiner cites to the portion of Clayton that describes beveled peripheral edges of elastomeric discs 40 as allegedly teaching dampening members with inclined faces. *Id.* at p. 4 (citing Clayton col. 4, ll. 30-59). Specifically, Clayton teaches that “the top and bottom peripheral edges of the discs 40 are beveled (i.e., chamfered) at an angle [creating] an annular space 42 between two juxtaposed discs[.]” Clayton at col. 4, ll. 41-44. Figure 2 of Clayton (reproduced here for reference) clearly shows that space 42 is directly adjacent to the beveled top and bottom peripheral edges of the discs 40 and that these beveled edges do not contact any structures. Further, nowhere does Clayton suggest or depict discs 40 as having a surface that contacts an adjacent structure inclined at an angle with respect to cylinder 26. See *id.* at Figs. 2, 3, and 4. Thus,

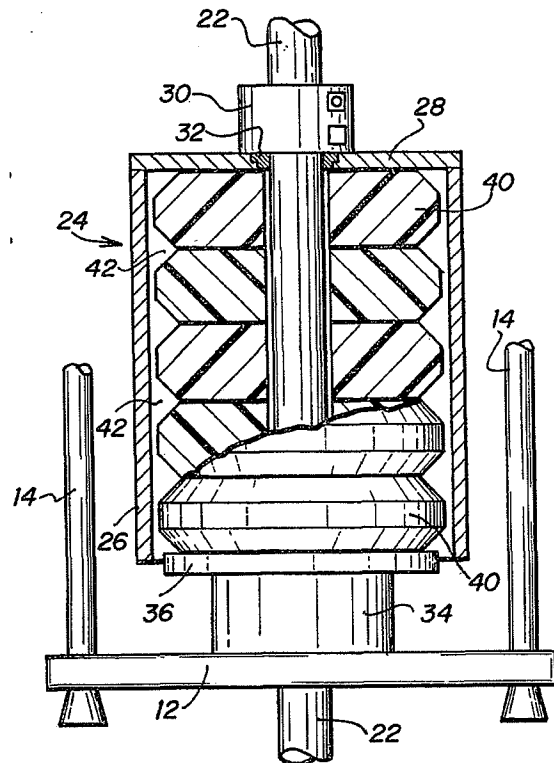


FIG. 2

Clayton fails to disclose, teach, or suggest the claimed “at least one inclined face contacting the enlarged end portion.”

Moreover, modifying the beveled edges of Clayton to contact another structure would not have been obvious to one of ordinary skill in the art, because this would change or destroy a principle of operation of Clayton. The beveled peripheral edges of Clayton are specifically designed to create “an annular space 42 between two juxtaposed discs 40[.]” *Id.* at col. 4, ll. 43-44 (emphasis added). The purpose of this annular space 42 is to optimally locate any heated air generated by the cyclical compression of discs 40. See *id.* at col. 4, ll. 50-56. Clayton notes that “[t]he location of this annular gap 42 between two juxtaposed discs is believed to be particularly advantageous... for efficient heat transfer[, because] the heated air is next to a steel member which is exposed on its outer side to the ambient air.” *Id.* at col. 4, ll. 46-54 (emphasis added). Accordingly, it is clear that the beveled edges taught by Clayton are expressly for creating a space or gap, and the space or gap operates to provide a peripheral location for heated air. Thus, modifying the beveled edges of Clayton to contact another structure, thereby eliminating the space or gap, would impair the mode of operation of this “particularly advantageous” feature. See *id.* at col. 4, ll. 40-50. The M.P.E.P. instructs that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” M.P.E.P. § 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). Therefore, since the proposed modification of Clayton would change a principal

of operation of Clayton, the teachings of Clayton are insufficient to render claim 13, as amended, *prima facie* obvious.

Because Clayton fails to disclose, teach, or suggest a dampening member with an “inclined face contacting [an] enlarged end portion,” it is respectfully submitted that claim 13 is patentable over Clayton. Further, Navas does not cure this defect, as Navas fails to disclose, teach, or suggest a dampening member with an inclined face, let alone an “inclined face contacting [an] enlarged end portion.” Thus, the section 103 rejection of claim 13 over Navas in view of Clayton should be withdrawn. Additionally, because claims 14-15, 17, and 18 all ultimately depend from claim 13, it is respectfully submitted that these claims are allowable for at least the same reasons as claim 13.

Rejection of Claims 16, 19, and 20 Under 35 U.S.C. § 103(a)

Under 35 U.S.C. § 103(a), claim 16 stands rejected as allegedly being unpatentable over Navas in view of Clayton in further view of U.S. Patent No. 6,241,730 to Alby (“Alby”), claim 19 stands rejected as allegedly being unpatentable over Navas in view of Clayton in further view of U.S. Patent No. 5,503,413 to Belogour (“Belogour”), and claim 20 stands rejected as allegedly being unpatentable over Navas in view of Clayton in further view of U.S. Patent No. 6,382,602 to Morrow (“Morrow”). Office Action at pp. 5-6. Claims 16, 19, and 20 ultimately depend from claim 13. Because neither Clayton nor Navas, alone or in combination, disclose, teach, or suggest the flexible vertebral linking device of claim 13, dependent claims 16, 19, and 20 also would not have been obvious over Navas in view of Clayton. Further, none of the secondary references remedy the deficiencies of Navas and Clayton. Applicants need not and do

not address the Examiner's contentions with respect to Alby, Belogour, and Morrow and certain elements of certain claims. By not addressing those contentions, Applicants in no way acquiesce to them.

Conclusion


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 

Nicholas S. Stroeher
Reg. No. 62,926
(617) 452-1647